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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

WOOD, K

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/147,175

Applicant(s)
DIII et al.

Examiner
Kimberly Wood

Group Art Unit
3632



☒ Responsive to communication(s) filed on Sep 1, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 13-20 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3632

This is the third office action for serial number 09/147,175, entitled Device For Holding A Paper Sheet, in response to Amendment B filed on September 1, 2000

Claim Rejections - 35 USC § 112

Claims 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim, the phrase "as seen in lateral projection" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. The applicant can not claim the invention in reference to views disclosed in the applicant's figures. Correction is required.

The examiner can not determine whether the applicant intends to the claim that the space between the first and second holding element is wider at the base than at the top or that the space progressively narrows to a greater extend near the top relative to the near the base. Claims 16-20 seem to be a contradiction in reference to the space. The applicant needs to clearly define whether the space is wider at the top than the bottom or vice versa.

Claim 16 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a second holding element having a protruding section and a first holding element mounted on a articulation interconnected to an actuating body, does not reasonably provide enablement for a second holding element having a protruding section and a first holding

Art Unit: 3632

element mounted on an articulation interconnected to an actuating body fitted with a compressible element. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. If the applicant has disclosed this feature within the drawings, then figure 5 should have the protrusion disclosed by providing a reference number.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for first holding element and a second holding element overlapping each other partially with the second holding element having a protruding section, does not reasonably provide enablement for a first, second, third and fourth holding elements with the first element having a protruding section and the first and second holding elements overlapping each other.. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a first element and a second element defining between them a space that is wider at the top than at the bottom or which progressively narrows from the top to the bottom, does not reasonably provide enablement for a first element and a second element defining between them a space that is wider at the top than at the bottom or which progressively narrows from the top to the bottom wherein the first element has a actuating body fitted with a compressible element. The specification does not enable any person skilled in the art to which it

Art Unit: 3632

pertains, or with which it is most nearly connected, to the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 19 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Fukuta JP 6323169. Fukuta (figures 3 and 4) discloses a first holding element (4) having two bearing surface and a second holding element (4) has a protruding section (near 8) having a space (near 3) between them.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3632

Claims 13 and 14 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman 5,857,654 in view of Liptak 4,125,243. Berman (figures 2-28) discloses a first holding element (7) having two bearing zones (7a) and a recess (the area between the right 7a and the left 7a), a second holding element (6) having a protruding section (See Figure 23) wherein there is a space between the first and second holding elements (See Figures 23 and 24). Berman discloses all of the claimed limitations of the invention except for the space being wider at the top than at the base. Liptak teaches that it is known to have a first holding element (13) and a second holding element (12) having a space (17) between the first and second holding element wherein the space is wider at the top than at the bottom (Figure 5 and 4). It would have been obvious to one having ordinary skill in the art at the time of the invention have modified Berman to have made the space between the first and second holding elements wider at the top than at the bottom as taught by Liptak for the purpose of helping support the paper or supported article between the holding elements as a result in the frictional engagement between the edge of the support article and the holding elements (7 and 6). It would have been an obvious matter of engineering design choice to have modified the shape and size of the holding elements (6 and 7) to have the progressively narrow space between them as taught by Liptak as suggested or motivated by the disclosure in Berman in Column 6, line 60ff, which states that "changes in structure, material, sizes, and shapes can be made by those skilled in the art without departing from the invention."

Art Unit: 3632

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiromori in view of Suzuki 5,845,889. Hiromori (Figures 3-10) discloses a first element (3), a second element (2), an articulation (7), an articulating body (8), a compressible element (4); the first and second holding element are tilted backwards. Hiromori discloses all of the limitations of the claimed invention except for a protruding section. Suzuki discloses a first holding element having two bearing zones (3), a second holding element having a protruding section (2). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Hiromori to have included the protruding section as taught by Suzuki for the purpose of providing a better means of securing.

Claims 17 and 19 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan 1,768,675. Egan discloses a first (41), a second (near 43), third (near 42) holding element having a space between them which progressively narrows. Claim 17 has been rejected based on the above 35 USC 112 rejection stated above. The applicant does not disclose in the specification that the species directed to figures 13 and 14 having a second element having a protruding section therefore, the claim has been rejected as best understood by the examiner.

Allowable Subject Matter

Claims 15 and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 3632

The following is an examiner's statement of reasons for allowance: the prior art does not disclose a device further comprising a base, wherein the bearing zones are connected near a top part of the device and separated by a gap near the base of the device.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments with respect to claims 13-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Scatterday 6,059,249


Scattterday discloses a conventional device for holding pages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Wood whose telephone number is (703) 308-0539. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. Any inquiry of a

Art Unit: 3632

general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168. The fax number for this Group is (703) 308-3691.


Kimberly Wood
September 30, 2000


LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER